

REMARKS

Applicant respectfully requests reconsideration. Claims 1-34 and 55-73 were previously pending in this application. By this amendment, Applicant is canceling claim 59 without prejudice or disclaimer. Claims 1, 7, 13, 14, 16, 19, 55-58, 60-63, 66, 69, 70, and 72 have been amended. As a result, claims 1-34, 55-58, and 60-73 are pending for examination with claims 1, 14, 55, 60-62, and 64 being independent claims. No new matter has been added.

Applicant thanks the Examiner for discussing the pending claims during a telephonic interview today (November 6, 2006) with the undersigned along with Edward Ingenito and Alexander Schwarz. During the interview, the prior art of record was discussed and certain aspects of the invention were explained. In particular, it was explained that Applicant provides non-surgical lung volume reduction methods that involve introducing material to alveolar regions of diseased lungs as opposed to blocking air passages with plugs of material. The substance of the interview is described in more detail in the following paragraphs.

Priority

Applicant acknowledges the reference to the requirements for priority in the Office Action. Applicant hereby amends the first sentence of the specification to include a specific reference to prior U.S. Patent Application Serial No. 09/379,460 filed on August 23, 1999, now issued as U.S. Patent No. 6,610,043. An application data sheet referring to this prior Application also is included along with this submission.

In accordance with 37 C.F.R. §1.78 (a)(ii)(C), Applicant believes that neither a petition nor a surcharge fee are required since this application is a “nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.”

Information Disclosure Statement

As suggested by the Examiner, Applicant has amended the specification to comply with the requirements of 37 C.F.R. §1.78 for claiming priority to US Serial No. 09/379,460. Accordingly,

Applicant respectfully requests that the non-patent literature references not submitted with the instant application but previously submitted with US Serial No. 09/379,460 be considered.

Applicant will provide copies of any non-patent literature references that were not submitted with the instant application and that the Examiner does not find in the Patent Office files for US Serial No. 09/379,460. Accordingly, Applicant respectfully requests that the Examiner indicate if any such references are required.

Rejection Under 35 U.S.C. §102

Claims 1-3, 6, 13-16, 18-19, 24, 31-34, 55-66 and 69-72 were rejected under 35 U.S.C. §102(e) as being anticipated by Perkins et al. (US Patent No. 6,287,290) referred to herein as “Perkins et al.”

Claims 1, 14, 55 and 60-62 and dependent claims thereon:

Applicant respectfully submits that the disclosure of Perkins et al. differs from the invention as presently claimed in independent claims 1, 14, 55 and 60-62. Perkins et al. reports on methods for partially collapsing a segment of a lung by aspirating the segment and optionally applying external pressure “on the segment to assist in complete collapse” as stated in the Abstract of US Patent No. 6,287,290. Perkins et al. also reports delivering material to block an air passage leading to a collapsed region of a lung. In contrast, as explained during the telephonic interview, the invention as presently claimed in independent claims 1, 14, 55 and 60-62 relates to introducing a material into a diseased alveolar region of a lung to reduce the volume of the diseased alveolar region (e.g., to promote collapse of the diseased region and/or to promote adhesion, fibrosis, or scarring within the diseased region). The aspect of introducing a material into a diseased alveolar region of a lung to reduce the volume of the diseased region is recited in independent claims 1, 14, 55 and 60-62 and therefore included in claims dependent thereon.

Perkins et al. fails to teach or even suggest introducing material into a diseased alveolar region of a lung to reduce the volume of the diseased alveolar region. The Office Action pointed to column 10, lines 37 etc. of Perkins et al. for a disclosure of biological material introduced to reduce the volume of the lung. However, Applicant respectfully submits that this section of Perkins et al.

reports delivering material to an air passage leading to a collapsed region of a lung for “sealing or occluding the air passage leading to the collapsed tissue region” (see column 10, lines 37-39). Perkins et al. further reports delivering a plug of material to “fully occupy and plug the air passage into the collapsed lung tissue region” (see column 10, lines 54-58 and Figure 11), wherein the collapsed lung tissue region was collapsed by aspiration (see column 10, lines 47-54). Therefore, Perkins et al. reports using certain material to occlude an air passage leading into a collapsed lung region, but Perkins et al. fails to disclose introducing material into a diseased alveolar region in order to reduce the volume of the diseased region.

Accordingly, withdrawal of the rejection of claims 1-3, 6, 13-16, 18-19, 24, 31-34, 55-63, 69, 70, and 72 under 35 U.S.C. §102(e) is respectfully requested.

Claim 64 and dependent claims thereon:

Applicant respectfully submits that the disclosure of Perkins et al. also differs from the invention as presently claimed in independent claim 64. Perkins et al. reports on methods for partially collapsing a segment of a lung by aspirating the segment and optionally applying external pressure “on the segment to assist in complete collapse” as stated in the Abstract of US Patent No. 6,287,290. However, Applicant submits that Perkins et al. fails to disclose or suggest collapsing a diseased lung region under conditions to promote fibrosis or scarring within the collapsed diseased region. The aspect of promoting fibrosis or scarring within a collapsed diseased region is recited in independent claim 64, and therefore included in dependent claims 65, 66, and 71.

The Office Action did not point to any specific section of Perkins et al. for a disclosure of a material that promotes fibrosis. Applicant submits that Perkins et al. fails to teach promoting fibrosis within a collapsed lung region in order to promote lung volume reduction.

Accordingly, withdrawal of the rejection of claims 64, 65, 66, and 71 under 35 U.S.C. §102(e) is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 17, 20-21 and 73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perkins et al. in view of Edwardson et al. (US Patent No. 5,739,288). Claims 22-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perkins et al. in view of Antanavich et al. (US Patent No. 5,814,022).

Applicant respectfully submits that Edwardson et al. and Antanavich et al. fail to overcome the shortcomings of Perkins et al. In particular these additional references both fail to teach or suggest introducing material to a diseased alveolar region or collapsing a diseased lung region under conditions to promote fibrosis or scarring within the collapsed region as recited in the amended claims. Therefore, the cited references, taken alone or in combination, fail to teach or suggest all of the claimed elements of claims 17, 20-23, or 73.

Accordingly, withdrawal of all the rejections under 35 U.S.C. §103 is respectfully requested.

Double Patenting Rejection

Claims 1-34 and 55-73 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-32 of US Patent No. 6,682,520 and claims 1-11 of US Patent No. 6,610,043. In response, Applicant submits appropriate terminal disclaimers without prejudice. Accordingly, withdrawal of this rejection is respectfully requested.

Allowable Subject Matter

Applicant acknowledges that claims 4-5, 7-12, 25-30 and 67-68 were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicant respectfully requests reconsideration of the remaining rejections in view of the amendments and remarks herein.

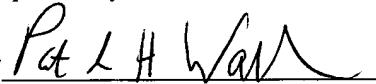
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: November 6, 2006

Respectfully submitted,

By 

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